

REMARKS

By this Amendment, Applicants amend claims 1, 2, 5-12, 14-16, 19, 20, 28, 29, 32-36, 38, 39, 41-43, 46, 47, 51, 53-77, and 79 and cancel claims 3, 4, 25-27, 30, 31, 52, and 80-82 without prejudice or disclaimer of the subject matter thereof. Claims 1, 2, 5-24, 28, 29, 32-51, and 53-79 remain pending in this application.

In the Office Action¹, the Examiner took the following actions:

objected to claims 25, 27, 80 and 81;

rejected claims 9, 12, 13, 36, 39, 40, 56, 65, 68, 70, and 72-79 under 35 U.S.C. § 112, second paragraph;

rejected claims 1-24, 28-79, and 81-82 under 35 U.S.C. § 101;

rejected claims 1-13, 16-19, 24-40, 43-46, 51-53, 56-64, 69-72, 75, 76, and 78-82 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,304,857 to Heindel et al. ("*Herindel*");

rejected claims 14 and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* in view of U.S. Patent Publication No. 2003/0208720 to Anderson et al. ("*Anderson '720*");

rejected claims 15 and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* in view of U.S. Patent No. 7,379,978 to Anderson et al. ("*Anderson '978*");

rejected claims 20, 47, and 66 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* in view of U.S. Patent Publication No. 2002/0038305 to Bahl et al. ("*Bahl*");

rejected claims 21, 22, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* in view of *Bahl* and U.S. Patent Publication No. 5,978,836 to Ouchi et al. ("*Ouchi*");

rejected claims 23 and 50 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* in view of *Bahl* and Official Notice;

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

rejected claims 54, 55, 73, 74, and 77 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* and *Ouchi*;

rejected claims 65 and 68 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* in view of U.S. Patent Publication No. 2003/0028495 to Pallante et al. ("*Pallante*"); and

rejected claim 67 under 35 U.S.C. § 103(a) as being unpatentable over *Herindel* in view of U.S. Patent Publication No. 2003/0145047 to Upton et al. ("*Upton*").

I. Objection to claims 25, 27, 80 and 81

The Office Action objected to claims 25, 27, 80, and 81 as being in improper form. As Applicants have cancelled the above claims, the objection is now moot. Therefore, Applicants request the Examiner to withdraw the objection.

II. Rejection of claims under 35 U.S.C. 112, second paragraph

The Office Action rejected to claims 9, 12, 13, 36, 39, 40, 56, 65, 68, 70, and 72-79 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. To advance prosecution, Applicants have amended the above claims to clarify the phrase "and/or." As such, Applicants request the Examiner to withdraw the rejection of claims 9, 12, 13, 36, 39, 40, 56, 65, 68, 70, and 72-79 under 35 U.S.C. 112, second paragraph.

III. Rejection of claims under 35 U.S.C. § 101

The Office Action rejected claims 1-24, 28-79, 81, and 82 rejected under 35 U.S.C. 101, for failing to recite statutory subject matter. Applicants have amended claim 1 to recite "enabling a second party, **using a processor**, to add one or more further data fields" (emphasis added). As such, claim 1 recites statutory subject matter, in view

of *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). Thus, rejection of independent claim 1 should be withdrawn. The rejection of independent claims 28, 53 and 72, which recite subject matter similar to those of claim 1, should be withdrawn for similar reasons. The rejection of claims 2, 5-24, 29, 32-52, 54-71, and 73-79, which depend from claims 1, 28, 53, and 72, should be withdrawn at least due to their dependence. Claims 3, 4, 30, 31, 81, and 82 have been cancelled and the rejection of these claims is not moot.

IV. Rejection of claims under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-13, 16-19, 24-40, 43-46, 51-53, 56-64, 69-72, 75, 76, and 78-82 under 35 U.S.C. § 102 as being anticipated by *Herindel*. In order to properly establish that *Herindel* anticipates Applicants' claims under 35 U.S.C. § 102, each and every element of each of the claims must be found, either expressly described or under principles of inherency, in that single reference. See M.P.E.P. § 2131 (8th Ed., Rev. 7, July 2008) (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). Applicants submit that *Herindel* does not teach each and every element of Applicants' claims.

Independent claim 1, as amended, recites a method for processing an electronic document, including "receiving, from the second party, information including a first data field, wherein the first data field is a data field selected from the plurality of data fields proposed by the first party according to the predefinable list," "receiving, from the

second party, information including a second data field, wherein the second data field is a data field provided by the second party,” and “producing an accounting record from the electronic bill, based on the first data field and the second data field.” *Herindel* does not teach, or even suggest, at least these elements of claim 1.

Herindel discloses an “electronic billing system.” (Abstract). Specifically, *Herindel* discloses that “[t]he billing statement 50 has a main body 58 that contains numerous data fields for the billing particulars. On the summary page of the energy bill, the billing data fields in 60 body 58 include an amount due, an amount previously paid, and a payment due date.” Col. 6, lines 57-61. More specifically, *Herindel* discloses using “[a] statement designer 62 [to] enable[] the biller to embed and organize data fields.” Col. 7, lines 30-31. That is, *Herindel* discloses allowing a biller to use data fields to customize the billings before they are sent to the customers. However, *Herindel* is completely silent with respect to allowing the customers to customize the billings by selecting data fields proposed by the biller. As such, *Herindel* fails to disclose, or even suggest, “receiving, from the second party, information including a first data field, wherein the first data field is a **data field selected from the plurality of data fields proposed by the first party** according to the predefinable list,” as recited in claim 1 (emphasis added).

Additionally, *Herindel* does not disclose receiving a “second ... data field provided by the second party,” as further recited in claim 1. As stated above, *Herindel* discloses allowing a biller to use data fields to customize the billings before they are sent to the customers. *Herindel* does not disclose allowing customers to customize billings by providing any data fields. Therefore, *Herindel* fails to disclose, or even suggest, “receiving,

from the second party, information including a second data field, wherein the second data field is a data field provided by the second party” and “producing an accounting record from the electronic bill, based on the first data field and the second data field,” as recited in claim 1.

For at least the above reasons, *Herindel* does not disclose at least “receiving, from the second party, information including a first data field, wherein the first data field is a data field selected from the plurality of data fields proposed by the first party according to the predefinable list,” “receiving, from the second party, information including a second data field, wherein the second data field is a data field provided by the second party,” and “producing an accounting record from the electronic bill, based on the first data field and the second data field,” as recited in amended independent claim 1. Therefore, *Herindel* does not disclose each and every element of amended independent claim 1 and *Herindel* does not anticipate the claim.

Independent claims 28, 53, and 72, although of a different scope from independent claim 1 and each other, are amended to include recitations similar to those discussed above in connection with independent claim 1. Accordingly, *Herindel* does not anticipate claims 28, 53, and 72 for at least reasons similar to this discussed above in connection with independent claim 1.

Claims 2, 5-13, 16-19, 24, 29, 32-40, 43-46, 51-51, 56-64, 69-71, 75, 76, 78, and 79 depend from independent claims 1, 28, 53, and 72. Accordingly, claims 2, 5-13, 16-19, 24, 29, 32-40, 43-46, 51-51, 56-64, 69-71, 75, 76, 78, and 79 are not anticipated by *Herindel* at least due to their dependence. Therefore, for at least these reasons, the Examiner should withdraw the rejection under 35 U.S.C. § 102(b). Claims 3, 4, 25-27,

30, 31, 52, and 80-82 have been cancelled and the rejection of these claims is now moot.

V. Rejections of Claims under § 103(a)

Applicants respectfully traverse the rejections of claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77 depend from independent claims 1, 28, 53, and 72. As discussed above, *Herindel* does not disclose or suggest “receiving, from the second party, information including a first data field, wherein the first data field is a data field selected from the plurality of data fields proposed by the first party according to the predefinable list,” “receiving, from the second party, information including a second data field, wherein the second data field is

a data field provided by the second party,” and “producing an accounting record from the electronic bill, based on the first data field and the second data field,” as recited in amended independent claim 1 and similar recitations of independent claims 28, 53, and 72. *Anderson '720, Anderson '978, Bahl, Ouchi, Official Notice, Pallante, and Upton*, either individually or in combination, do not compensate for the deficiencies of *Herindel*, as discussed above. That is, *Herindel, Anderson '720, Anderson '978, Bahl, Ouchi, Official Notice, Pallante, and Upton* also do not disclose or suggest “receiving, from the second party, information including a first data field, wherein the first data field is a data field selected from the plurality of data fields proposed by the first party according to the predefinable list,” “receiving, from the second party, information including a second data field, wherein the second data field is a data field provided by the second party,” and “producing an accounting record from the electronic bill, based on the first data field and the second data field,” as recited in amended independent claim 1 and similar recitations of independent claims 28, 53, and 72.

At least due to their dependence, the elements of claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77 are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims, and no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77, and the Examiner should withdraw the rejections of the claims under 35 U.S.C. § 103(a).

CONCLUSION

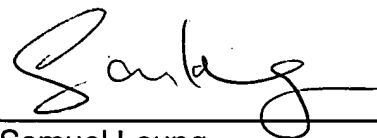
In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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